

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1 have been amended. No claims have been added or canceled. Thus, claims 1-19 are pending.

OBJECTION TO THE SPECIFICATION

The specification was objected to for missing a summary. A summary has been added by the present amendment. Accordingly, Applicants request that the objection to the specification be withdrawn.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

Claims 1-19 were rejected as being as being unpatentable over U.S. Patent No. 6,427,164 issued to Reilly (hereinafter "*Reilly*") in view of U.S. Patent No. 5,923,848 issued to Goodhand, et al. (hereinafter "*Goodhand*"). For at least the reasons set forth below, Applicants submit that claims 1-19 are not rendered obvious by *Reilly* and *Goodhand*.

Claim 1 recites the following:

receiving a document by a document distribution server;
recording in a database a document identifier and the distribution
list;
distributing the document to said members of the distribution list;
receiving, in response to distributing to a first member of the
distribution list, an error message comprising the document identifier;
looking up the document identifier in the database so as to identify
the distribution list; and
automatically deleting the destination address for the first member
from the distribution list so that a subsequent sending to the distribution
list avoids corresponding subsequent error messages.

Claim 11 is directed to a machine-accessible medium and recites similar limitations.

The Final Office Action of October 31, 2003, page 3 cites the following passage from *Reilly* as disclosing the document identifier.

551 User not local; please try <forward-path>

This reply indicates that the receiving server knows the user's mailbox in on another host server and indicates the correct forward-path to use. Note that either the host or user or both may be different. The receiving server generally refuses to accept mail for this user, and the sending server must either redirect the mail according to the information provided or return an error response to the originating user.

See col. 8, lines 8-14. Thus, *Reilly* discloses providing an error message with an identifier of the user and an indication of a forwarding address. *Reilly* does not disclose providing an identifier of a document as claimed in claims 1 and 11.

Moreover, *Reilly* discloses providing a forwarding path for the user when the user's e-mail address has changed or provides automatic forwarding. See col. 8, lines 31-33. In contrast, claim 1 recites removing the user from a distribution list and does not recite forwarding the message and/or document to the user's new address. Therefore, *Reilly* **teaches away** from the invention as claimed in claims 1 and 11.

Applicants agree with the Final Office Action mailed October 31, 2003 that *Reilly* does not disclose automatically deleting the first member from the distribution list. See page 3, last paragraph. *Goodhand* is cited to teach deletion of the first member from the distribution list. Applicants submit that **even if** *Goodhand* does disclose deletion of the first member from the mailing list, *Goodhand* is not cited to teach, nor does *Goodhand* teach or suggest, providing an identifier of a document and identifying a distribution list based on the document identifier as claimed in claims 1 and 11. Therefore, *Goodhand* cannot cure the deficiencies of *Reilly*.

Goodhand teaches the an address book can be edited. Specifically, *Goodhand* discloses:

MAPI's Personal Address Book is an example of a modifiable address book container that allows new entries to be added and exiting entries to be modified or deleted.

See col., 13, lines 51-54. However, *Goodhand* does not disclose:

automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages.

as recited in claims 1 and 11. Therefore, in view of the multiple deficiencies of *Reilly* and *Goodhand*, Applicants submit that no combination of *Reilly* and *Goodhand* can teach or suggest the invention as claimed in claims 1 and 11.

Claims 2-7 depend from claim 1. Claims 12-16 depend from claim 11. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-7 and 12-16 are not rendered obvious by *Reilly* and *Goodhand* for at least the reasons set forth above with respect to claims 1 and 11.

Claim 8 recites:

executing an e-mail application program utilizing a selected one of: Microsoft Messaging Application Programming Interface (MAPI)-based, and Microsoft Active Messaging;
addressing the electronic document to the distribution list;
recording in a database a document identifier cross-referencing the electronic document with the distribution list;
sending the electronic document with said MAPI application program;
distributing the electronic document to members of the distribution list;
receiving an error message for said distributing to the nonexistent member, said error message comprising the document identifier;
looking up the document identifier of said error message in the database so as to identify the distribution list; and
deleting the nonexistent member from the distribution list.

Thus, Applicants claim a document identifier. Claim 17 is directed to a machine-accessible medium and recites similar limitations.

As discussed above neither *Reilly* nor *Goodhand*, alone or in combination, teaches or suggests use of a document identifier to identify a distribution list and to delete a nonexistent member from the distribution list. Therefore, no combination of *Reilly* and *Goodhand* can teach or suggest the invention as claimed in claims 8 and 17.

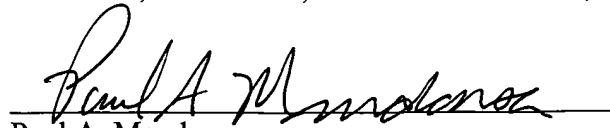
Claims 9 and 10 depend from claim 8. Claims 18 and 19 depend from claim 17. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 9, 10, 18 and 19 are not rendered obvious by *Reilly* and *Goodhand* for at least the reasons set forth above with respect to claims 8 and 17.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-19 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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